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Berthold Kathan

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EXAMINER

AVERY, JEREMIAH L

ART UNIT

PAPER NUMBER

2431

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/533,148	Applicant(s) KATHAN, BERTHOLD	
	Examiner JEREMIAH AVERY	Art Unit 2431	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 53-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 53-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- I. Claims 27-52 have been cancelled.
- II. Claims 53-67 have been added and examined.
- III. Responses to Applicant's remarks have been given.

Response to Arguments

- 1. Applicant's arguments filed 07/30/09 have been fully considered but they are not persuasive.
- 2. With regards to the Applicant's arguments pertaining to the "service computer", "authentication server" and printer", the Examiner upholds that Wu discloses these devices.
- 3. With regards to the "service computer", it is not specified within the claim language as to what sort of "servicing" is being conducted. Within Wu, there is a "hardware device" which "controls the printing" and further, but not limited to, page 2, paragraph 50 and page 3, remainder of paragraph 50 and paragraph 52 of Wu, the "hardware device" acts "on behalf of the server and/or a secure software program to implement the printing controls at the receiver" Further, on page 12, paragraph 332, "Each user has their own hardware device, which can be coupled to the user's machine when and as required, and removed after use". Thus, the Examiner upholds that the "hardware device" is working in conjunction with the "user's machine" to provide a necessary service of controlling access to and using of a printing device.
- 4. Further, the "server" is disclosed by Wu, as cited below. The server within Wu sends, inter alia, license keys to various recipients as well as conducts a verification

Art Unit: 2431

process of users within the system. Also, the Applicant's "printer" is further disclosed within Wu, as cited below with the various process(es) of said printer being controlled (e.g. what can be printed and how many copies can be printed, as well as who may be authorized to conduct printing operations).

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 53-67 are rejected under 35 U.S.C. 102(e) as being anticipated by United States Patent Application Publication No. US 2002/0042884 to Wu et al., hereinafter Wu.

5. (New) Regarding claims 53 and 67, Wu teaches a method and system for authenticating a service computer for connection to a printing or copying system to be serviced, comprising the steps of:

generating a transaction information by an authentication server and delivering the transaction information to a user of said service computer, said transaction information being entered by the user of the service computer into the service computer in order to execute authentication of the service computer (page 4, paragraphs 104-106, page 5 and paragraphs 112 and 117,);

generating first data by the service computer with aid of the transaction information, said first data including a hardware identifier of hardware contained in the service computer (page 9, paragraph 218, "the ID of their hardware device");

Art Unit: 2431

transmitting said first data from the service computer to the authentication server over a data line (page 5, paragraphs 112-117, page 6, paragraph 141 and page 11, paragraphs 281-285);

generating key data by the authentication server depending on the first data and transmitting the key data from the authentication server to the service computer over the data line, said key data defining access rights of the service computer (page 2, paragraph 46 and page 3, paragraph 54, “the server generating a new license key set and a new top-up key”);

with the service computer generating authentication information for authenticating the service computer with aid of the key data (page 5, paragraphs 112-117, page 6, paragraph 141 and page 11, paragraphs 281-285);

transmitting the authentication information from the service computer to a system control unit of said printing or copying system (Figure 5, page 4, paragraph 104);

verifying authenticity of the service computer by the system control unit; and

with the system control unit checking said access rights defined by the key data of the service computer, and if access is authorized, servicing the printing or copying system with the service computer (page 2, paragraphs 32, “usage control” and 35, “sender may be the one who authorizes the document” and 47, page 3, paragraphs 54, 57 and 58, page 4, paragraphs 89-91 and 95, page 6, paragraph 155, “checks the database record of sender’s definition to see if they are allowed to print the document, and how many copies they are allowed to print”).

Art Unit: 2431

6. (New) Regarding claim 54, Wu teaches wherein a check is performed to determine whether the service computer contains the hardware identifier (page 3, paragraph 52, page 9, paragraph 218, “the ID of their hardware device”, page 13, paragraph 340, “a hardware device for that receiver, which has a unique ID key” and page 15, paragraph 402).
7. (New) Regarding claim 55, Wu teaches wherein the key data contain an expiration date in addition to said access rights (page 3, paragraphs 55-57 and, page 10, paragraphs 242, 243 and 261).
8. (New) Regarding claim 56, Wu teaches wherein the access rights are assigned with aid of an authorization level (page 2, paragraph 35, “sender may be the one who authorizes the document” and 47, page 3, paragraphs 54, 57 and 58, page 4, paragraphs 89-91 and 95, page 6, paragraph 155, “checks the database record of sender’s definition to see if they are allowed to print the document, and how many copies they are allowed to print” and page 7, paragraphs 167 and 171).
9. (New) Regarding claim 57, Wu teaches wherein the key data are transmitted in encrypted form (page 3, paragraph 54 and page 8, paragraph 189, “delivered to the client in an encrypted format”).
10. (New) Regarding claim 58, Wu teaches wherein the data line comprises a network connection (page 1, paragraphs 13-24, page 3, paragraph 58 and page 15, paragraph 504).

Art Unit: 2431

11. (New) Regarding claim 59, Wu teaches wherein the data line comprises a point-to-point connection (page 2, paragraph 37, page 5, paragraphs 128-136, “provides a secure channel between two parties” and page 6, paragraph 137).

12. (New) Regarding claim 60, Wu teaches wherein the transaction information comprises a transaction number (page 3, paragraph 61, page 5, paragraphs 121, 131-135 and page 9, paragraph 210, “a valid user can only access their block by providing the correct password”).

[According to the Applicant's Specification, the “transaction number is a series of numbers and/or letters that a human operator must enter at the service and maintenance computer in order to execute the approval procedure. The transaction number generated by the authorization server 16 is sent to the operator by mail or e-mail.” The Examiner broadly interprets the claimed “transaction number” to pertain to the “password” disclosed by Wu.]

13. (New) Regarding claim 61, Wu teaches wherein the transaction information is sent per e-mail or mail to the user (page 2, paragraph 38, page 5, paragraph 112 and page 6, paragraph 149).

14. (New) Regarding claim 62, Wu teaches wherein the transaction information that is sent to the service computer is entered by way of an input unit of the service computer (page 2, paragraphs 26, 44 and 46).

15. (New) Regarding claim 63, Wu teaches wherein said hardware identifier of the service computer that cannot be modified by a user is used as said hardware identifier (page 3, paragraph 52, page 9, paragraph 218, “the ID of their hardware device”, page

Art Unit: 2431

13, paragraph 340, “a hardware device for that receiver, which has a unique ID key” and page 15, paragraph 402).

16. (New) Regarding claim 64, Wu teaches wherein said authenticity verifying by the authentication server is performed with aid of a challenge/response procedure (page 3, paragraph 61, “accessed only when a password of the user is entered and verified”, page 5, paragraphs 121, 130-135 and page 6, paragraphs 137-141 and 143-153, page 8, paragraph 205, page 9, paragraph 210, “a valid user can only access their block by providing the correct password”).

17. (New) Regarding claim 65, Wu teaches wherein the key data contain a signed certificate (page 4, paragraphs 103-106 and page 5, paragraphs 107 and 112).

18. (New) Regarding claim 66, Wu teaches wherein the key data contains a key, and the authentication information sent to the printing or copying system contains an authentication code generated with the aid of the key (page 2, paragraph 46, page 3, paragraph 54, “the server generating a new license key set and a new top-up key”, page 5, paragraphs 112-117, page 6, paragraph 141 and page 11, paragraphs 281-285).

Conclusion

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2431

20. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

22. The following United States Patents are cited to further show the state of the art with respect to access control and the secure transmission of data, such as:

United States Patent No. 7,421,411 to Kontio et al., which is cited to show digital rights management in a mobile communications environment.

United States Patent No. 6,233,577 and 6,516,316 to Ramasubramani et al., which are cited to show a centralized certificate management system for two-way interactive communication devices in data networks.

United States Patent No. 7,290,288 to Gregg et al., which is cited to show a method and system for controlling access, by an authenticated server, to protected computer resources.

United States Patent No. 6,424,954 to Leon, which is cited to show a postage metering system.

Art Unit: 2431

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEREMIAH AVERY whose telephone number is (571)272-8627. The examiner can normally be reached on Monday thru Friday 8:30am-5pm.

24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Korzuch can be reached on (571) 272-7589. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeremiah Avery/
Examiner, Art Unit 2431
/Syed Zia/
Primary Examiner, Art Unit 2431